



06 MAR 2008

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In re Application of
GREDLEY, Sarah
Application No.: 10/521,139
Filing Date: 12 January 2005
Attorney Docket No.: 006329.00005
For: PICTURE FRAME

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This decision is in response to applicant's "Renewed Petition under 37 CFR 1.137(b)" filed 08 November 2006 in the above-captioned application. Additionally, this decision is in response to applicant's "Petition (Conditional) under 37 CFR 1.78(a)(3) to Accept Late Claim of Priority" filed 08 November 2006 and applicant's "Status Inquiry" submitted on 18 June 2007. Additionally, this decision is in response to applicant's "Second Status Inquiry" submitted on 22 October 2007.

BACKGROUND

On 23 May 2003, applicant filed international application PCT/GB03/02228 which claimed a priority date of 23 May 2002. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 23 November 2004.

On 12 January 2005, applicant filed, *inter alia*: a transmittal letter to the US Designated/Elected Office Concerning a Filing under 35 U.S.C. 371; an application containing a specification, including claims and drawings; a Fee transmittal for FY 2005; copy of the international application; a preliminary amendment for continuation of PCT/GB03/02228; an application data sheet; and the instant petition and fee to revive the international application as to the United States under 37 CFR 1.137(b). In a decision dated 04 January 2006, applicant petition under 37 CFR 1.137(b) was dismissed without prejudice. Further, applicant was notified that the submission would be treated under 35 U.S.C. 111, not 35 U.S.C. 371.

On 06 March 2006, applicant filed a "Renewed Petition under 37 CFR 1.137(b)." In a decision dated 09 August 2006, applicant petition under 37 CFR 1.137(b) was dismissed without prejudice.

On 08 November 2006, applicant filed the present "Request for Reconsideration Renewed Petition under 37 CFR 1.137(b)" and "Petition (Conditional) under 37 CFR

1.78(a)(3) to Accept Late Claim of Priority.

STATUTE AND REGULATION

35 U.S.C. § 41(a)(7) provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." Specifically, 35 U.S.C. § 41(a)(7) provides:

On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$110.

37 CFR 1.137(b) provides:

Unintentional. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;*
- (2) The petition fee as set forth in § 1.17(m);*
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and*
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.*

OPINION

Where there is a question whether the delay was unintentional, applicant (Sarah Gredley) must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). The circumstances of the above-identified application raise a question whether the delay was "unintentional":

Where the applicant deliberately permits an application to become abandoned (*e.g.*, due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as

“unintentional” within the meaning of 37 CFR 1.137(b). . . . A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an “unintentional delay within the meaning of 37 CFR 1.137(b) because: . . . (E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and prosecution expenses.

See Changes to Patent Practice and Procedure: Final Rule Notice, 62 Fed. Reg. 53131, 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 86 (October 21, 1997)(citations omitted).

The Declaration of Yvonne Catherine Johnson states: (1) that she contacted Sarah Gredley, via telephone, on how to proceed with international patent application; (2) that she mailed a letter to Sarah Gredley regarding the deadline to the enter national stage; and (3) she subsequently contacted Sarah Gredley, on 17 November 2004, which reiterated the deadline for filing the basic national fee.

In spite of the above, Sarah Gredley admits that the delay was “due to mistaken belief that the U.S. National phase application could be filed later.” However, the intentional delay in this case is not affected by Sarah Gredley’s “mistaken belief” not to enter the U.S. National stage. This action was a deliberate course of action as discussed above and, thus, resulted in an intentional delay in filing the required fee under 37 CFR 1.495(b) to enter the national stage in the United States (See Manual of Patent Examining Procedure §711.03, Page 700-192 and Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159) (a course of conduct resulting in delay that is purposefully chosen does not qualify as an unintentional delay).

Further, Sarah Gredley’s attorney was aware of the consequences in failing to meet the deadline for entry into the U.S. national stage (See Declaration of Yvonne Catherine Johnson). An attorney’s knowledge and deliberate actions may be imputed to the applicant himself. See Link v. Wabash R.R. Co., 370 U.S. 626, 634, 82 S. Ct. 1386, 8 L. Ed. 2d 734 (1962) and New York University v. Autodesk, Inc., 2007 U.S. Dist. LEXIS 50832 (S.D.N.Y., Jul. 13, 2007) (an applicant is bound by its attorney’s actions and “is considered to have notice of all facts, ‘notice of which can be charged upon the attorney.’”); Lawman Armor Corp. v. David A Simon, 2005 U.S. Dist. LEXIS 10843 (E.D. Mich., March 29, 2005) (action of attorney binding on applicant even though attorney was unable to contact applicant). Accordingly, on the present record, applicant is bound by her attorney’s decision to abandon the international application as to the United States.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice and the application remains **ABANDONED**.

The “Petition (Conditional) under 37 CFR 1.78(a)(3) to Accept Late Claim of Priority” is being held in abeyance.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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